

REMARKS

Claims 35-43, 47, 49, 51 and 52 are pending in this application. Claim 35 is the independent claim. By this Amendment, claims 35 and 47 are amended and claim 52 is added. No new matter is added.

Rejections Under 35 U.S.C. §103 over Neveu/DeVault

Claims 35-43, 47, 49 and 51 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 3,961,418 to Neveu in view of U.S. Patent 2,106,796 to DeVault. The rejection is respectfully traversed.

Applicants respectfully submit that a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was independently known in the prior art (35 U.S.C.A. § 103). For example, in making an assessment of the differences between the prior art and the claimed subject matter, 35 USC §103 specifically requires consideration of the claimed invention “as a whole.” The “as a whole” instruction in §103 prevents evaluation of the invention on a part-by-part basis. Without this important requirement, an obviousness assessment might break an invention into its component parts, then find a prior art reference corresponding to each component. This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components (*Ruiz v. A.B. Chance., Co.*, 357 F.3d 1270, 1275, (Fed. Cir. 2004)).

Further, there is no suggestion for combining the references as proposed in the Office Action because Neveu specifically excludes a combination with the blade, as taught by De Vault. Therefore, Neveu teaches away from De Vault. It is improper to combine references where the references teach away from their combination (MPEP §2145(IX)(D)(2)).

For example, it is alleged in the Office Action that would have been obvious to replace the cutting blade 22 of Neveu with the peeling blade 10 of De Vault. However, to maintain the operability of the Neveu device it would be necessary to replace the cutting blade 22 with a cutting blade having the same functions. Neveu describes the two major functions of a lemon peeler in column 2, lines 35 to 43, namely the capability of accommodating slight variations in size, in view of the thickness of the white membrane separating the skin from the meat of the fruit and the arcuate shape of the blade 22. In contrast, the peeling blade of De Vault is straight and includes an edge 20, a slot 21 and a guide bar 22 and, therefore, is designed for cutting off peels with a constant thickness. The element including the edge 20, the slot 21 and the guide bar

22 of De Vault does not conform to the arcuate shape of lemons and therefore there is no way of accommodating variations in the thickness as expected by Neveu. Thus, modifying the device of Neveu with the teachings of De Vault would render Neveu useless for its intended purpose.

Further, a major feature of the blade disclosed by De Vault is the portion 32 (column 2, lines 33-35) which cannot be combined with the holder of Neveu because it would disable grasping the holder between thumb and finger. Thus, the function of the portion 32 (and not the function of the edge 20, the slot 21 and a guide bar 22) includes gouging purposes (column 2, lines 48, 49) which would be similar to the cutting purpose of blade 22 of Neveu.

Regarding the holder, Neveu teaches to hold the lemon in the right hand, to push it against the cutting blade in order to cut through the skin to the white membrane and then to rotate the lemon about its longest axis (col. 2, lines 28 to 35). With the peeling blade of De Vault it would not be possible to first cut down to the white membrane and only at this position to start rotating the lemon. With the holder of Neveu, the cutting blade and the holder are at rest while the lemon is rotated. In contrast, with De Vault the holder is pulled and the peeling blade is located relative to the peeling direction at the rear end of the peeler. Thus, modifying Neveu with the teachings of De Vault would render the Neveu device useless for its intended purpose.

According to the obviousness tests under *Graham v. John Deere Co.*, the scope and content of the prior art are to be determined by itself and that differences between the prior art and the claims have to be ascertained. As discussed above, Neveu and De Vault are not combinable without alterations that would change the functionality of the combined elements.

Even considering *arguendo* that the references were combinable, the combination of references fails to disclose or suggest each and every feature recited in the rejected claims. For example, the combination of references fail to disclose or suggest, a vegetable peeler for peeling in a peeling direction, comprising...a cutting edge and a guiding piece that regulates a thickness of a removed peel, the two lateral gripping surfaces together with the interconnecting cross-piece form a substantially U-shaped holder, the vegetable peeler being shorter in the peeling direction than a distance between the lateral gripping surfaces at the peeling blade, and wherein the distance between the lateral gripping surfaces at the peeling blade is larger than a length and a height of the vegetable peeler, the length in the peeling direction of the vegetable peeler is larger than the height of the vegetable peeler and the cross-piece extends relative to the peeling direction above the peeling blade when used, as recited in independent claim 35.

Applicants respectfully remind the Examiner that, as discussed and agreed during the personal interview conducted on October 4, 2007, the length L extends along peeling direction A shown in Fig. 1. Therefore, length L shown in his drawing in Appendix A of the Office Action should be replaced by the height H and the length L parallel to PD in his figure in Appendix B.

Neveu relates to a device for cutting off strips of lemon rind for a desired purpose (column 2, lines 25-46). The claimed peeler of Neveu has a generally horseshoe-shaped frame 10. The frame 10 may be provided with a concave recess 14 so that the frame may be directed by a thumb and index finger of a person. An arcuate shaped blade 22 is fastened within the frame 10 by having its ends mounted against apertures 24 formed in the inner surface 26 of the frame 10 (column 1, line 59 – column 2, line 43; Figs. 1 and 2). In use, a lemon is rotated manually about its longest axis to remove the skin or rind of the lemon as schematically illustrated at Fig. 5.

It is alleged in the Office Action that Neveu discloses two lateral gripping surfaces 100 interconnected by a blade 22 and a cross piece 102, wherein the two lateral surfaces together with the cross piece form a substantially U-shape holder, and the peeler is shorter in the peeling direction than a distance between the lateral surfaces of the peeling blade. Applicants note that the Office Action provides a new figure that is not disclosed in Neveu and relies on the new in support of the allegations in the Office Action (see Appendix A of the outstanding Office Action).

In the new figure provided by the Examiner, it is alleged that the inner part (100) of the frame 10 are lateral gripping surfaces. However, as the inner part of the frame is not a gripping surface according to the clear disclosure of Neveu, the new interpretation of the reference using a new figure is incorrect. Rather, Neveu clearly describes and labels recesses 14 for gripping the peeler (see Fig. 2).

Moreover, the Examiner proposes to re-label the frame 10 as a “cross-piece” 102. However, as the frame 10 is shown and clearly described in Neveu, the frame is not a “cross-piece” merely because the Examiner chooses to re-characterize the disclosure of Neveu. Additionally, in contrast to the frame 10 of Neveu, the claimed “cross-piece extends relative to the peeling direction above the peeling blade when used.”

It is admitted in the Office Action that Neveu fails to disclose or suggest that “the peeling blade has a cutting edge and a guiding piece, each lateral gripping surface includes a bearing for the blade, the blade is formed as a pendulum blade rotatably held at the gripping surfaces.” In

an effort to overcome these admitted deficiencies, De Vault is combined as allegedly teaching the deficient features. However, as discussed above, De Vault is not combinable with Neveu. Further, De Vault fails to overcome the deficiencies of Neveu. For example, De Vault fails to disclose or suggest, a "cross-piece extends relative to the peeling direction above the peeling blade when used." Accordingly, withdrawal of the rejection is respectfully requested.

New Features/Claim

The combination of references, whether considered alone or in combination, disclose or suggest, the vegetable peeler according to claim 35, wherein the cross-piece is flat, or the vegetable peeler according to claim 47, wherein the peeling blade and the cross-piece are arranged such that the peeling blade is observable from above.

CONCLUSION

In view of the above remarks and amendments, the Applicants respectfully submit that each of the pending objections and rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Donald J. Daley, Reg. No. 34,313, at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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